



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/549,410	04/14/2000	Nicholas G. Fazzano	18102/55456	9420

26646 7590 06/19/2003

KENYON & KENYON
ONE BROADWAY
NEW YORK, NY 10004

EXAMINER

FUREMAN, JARED

ART UNIT	PAPER NUMBER
----------	--------------

2876

DATE MAILED: 06/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/549,410	FAZZANO, NICHOLAS G.
	Examiner	Art Unit
	Jared J. Fureman	2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 19 September 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-19 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 14 April 2000 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of the power of attorney, filed on 5/9/2002, the power of attorney, filed on 7/29/2002, the petition for extension of time and the amendment filed on 9/19/2002; all of which have been entered in the file. Claims 1-19 are pending.

Specification

1. The disclosure is objected to because of the following informalities: There is a lack of support in the specification for a radiant energy source (as recited in claims 4, 8, and 15). Page 5 of the specification describes that the cancellation device 36 may include a thermal device or a chemical device, but does not specifically recite a radiant energy source.

Appropriate correction is required.

Claim Objections

2. Claims 1, 4, 5, 14 and 15 are objected to because of the following informalities:

Re claim 1, line 15: "the" (second occurrence) should be deleted, in order to improve readability of the claim.

Re claim 4, line 8: --the unplayed-- should be inserted after "to", in order to maintain consistency with "unplayed lottery ticket".

Re claim 5, line 4: --:-- should be inserted after "of".

Re claim 14, line 4: --unplayed lottery-- should be inserted before "ticket", in order to maintain consistency with "unplayed lottery ticket".

Re claim 15, line 4: --unplayed lottery-- should be inserted before "ticket", in order to maintain consistency with "unplayed lottery ticket".

Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (US 6,086,477) in view of Ehrhart et al (US 6,186,404 B1, previously cited) and Beaty (US 5,682,819, previously cited).

Walker et al teaches a lottery terminal (33), system and method capable of reading a uniquely numbered lottery ticket (not shown) having a control number (for example, the ticket identifier 54, which is recorded in the ticket database 40 at server 30), the terminal comprising: a microprocessor (33) for controlling the operation of the terminal; means (43) for reading the lottery ticket, including the control number; memory means (37) for storing data, including the control number, pertinent to the lottery ticket; an input/output device (41) in communication with the controller (see figures 3A, 3B, 14, 15, column 5 line 58 - column 6 line 65, and column 14 lines 8-41).

Walker et al fails to specifically teach the lottery terminal being capable of canceling a uniquely numbered lottery ticket, the lottery ticket having an area with thermally/chemically reactive coating material disposed thereon, an automated lottery ticket cancellation device including means for receiving the lottery ticket therein and a

Art Unit: 2876

thermal/radiant energy/chemical device for permanently marking the lottery ticket at the area when positioned adjacent the thermal/radiant energy device.

Ehrhart et al teaches a lottery terminal (510), system and method capable of canceling a uniquely numbered lottery ticket (202) having an area (412') with thermally/chemically reactive coating material disposed thereon; the terminal comprising: imaging means (516 and 517) for imaging the lottery ticket; an automated lottery ticket cancellation device (brander 520) including means for receiving the lottery ticket therein and a thermal/radiant energy/chemical device (see column 15 lines 25-43, the brander may be a heat source or a light source, the light produced by the light source can be considered a chemical, since the light produces a reaction with the brandable material) for permanently marking the lottery ticket at the area when positioned adjacent the thermal/radiant energy device (see figures 1-1, 4-7, 5-1, 5-2, column 4 lines 43-60, column 5 lines 24-37, column 14 lines 22-45, column 14 line 66 - column 15 line 11, column 15 lines 26-43, and column 17 lines 15-40).

In view of Ehrhart et al's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system and method as taught by Walker et al, the lottery terminal being capable of canceling a uniquely numbered lottery ticket, the lottery ticket having an area with thermally/chemically reactive coating material disposed thereon, an automated lottery ticket cancellation device including means for receiving the lottery ticket therein and a thermal/radiant energy/chemical device for permanently marking the lottery ticket at the area when positioned adjacent the thermal/radiant energy device, in order to visibly cancel the

Art Unit: 2876

lottery ticket, thereby indicating to users that the ticket has been redeemed and thus, preventing multiple redemptions of a winning ticket.

Walker et al as modified by Ehrhart et al fails to specifically teach canceling an unplayed lottery ticket; the cancellation device permanently marking the unplayed lottery ticket prior to imaging the unplayed lottery ticket; the input device being configured to receive a request to cancel an unplayed lottery ticket and to communicate the request to the controller; the controller being configured to activate the cancellation device in response to the request communicated; the output device being configured to produce an indication that a refund should be provided for a canceled ticket only after the ticket has been permanently marked and the permanent mark has been detected.

Beaty teaches a lottery terminal (not shown), system and method capable of canceling an unplayed lottery ticket (see column 1 lines 23-38 and figure 3), the terminal comprising: imaging means (a scanner) for imaging the unplayed lottery ticket; an automated cancellation device (a printer, for example) including means for receiving the unplayed lottery ticket therein and permanently marking (void mark 30) the unplayed lottery ticket prior to imaging the unplayed lottery ticket; while not shown, the terminal/printer necessarily includes an input device to allow a user to enter data or indicate the desired operation and activate the terminal/printer; Beaty teaches that mistakes happen that must be cancelled (see column 1 lines 23-28), thus suggesting a refund or replacement of the unplayed lottery ticket (see figure 3, column 1 lines 23-63, column 2 lines 16-20, 50-63, and column 3 lines 19-26).

Art Unit: 2876

In view of Beaty's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system and method as taught by Walker et al as modified by Ehrhart et al, canceling an unplayed lottery ticket; the cancellation device permanently marking the unplayed lottery ticket prior to imaging the unplayed lottery ticket; the input device being configured to receive a request to cancel an unplayed lottery ticket and to communicate the request to the controller; the controller being configured to activate the cancellation device in response to the request communicated; the output device being configured to produce an indication that a refund should be provided for a canceled ticket only after the ticket has been permanently marked and the permanent mark has been detected, in order to ensure that the unplayed lottery ticket has been marked prior to being canceled my the terminal, thereby preventing cancellation of a lottery ticket without being permanently marked, thus preventing fraud.

Response to Arguments

5. Applicant's arguments filed 9/19/2002 have been fully considered but they are not persuasive.

In response to applicant's argument that neither Beaty nor Ehrhart describe a system for canceling unplayed lottery tickets (see page 8 of the amendment filed on 9/19/2002), Beaty teaches that mistakes may happen during the purchase of a lottery ticket, and that these mistakes must be cancelled (see page 1 lines 23-28). Thus, Beaty teaches that a printed lottery ticket containing a mistake must be cancelled, this lottery ticket is an unplayed ticket.

In response to applicant's argument that there is no suggestion to combine the references (see page 9 of the amendment filed on 9/19/2002), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Beaty teaches canceling unplayed lottery tickets that contain a mistake, and that marking the ticket before imaging the ticket provides greater fraud protection (see column 1 lines 23-63). Thus, the teachings of Beaty provide the motivation for combining Beaty with the Walker et al and Ehrhart et al.

In response to applicant's argument that the proposed combination would be unusable (see pages 9-10 of the amendment filed on 9/19/2002), Ehrhart et al teaches that the symbol may still be read by the bar code reading machine even after the symbol has been branded (see column 14 line 66 - column 15 line 11). Thus, the branding would make the bar code unreadable to a user, but not the lottery ticket terminal.

In response to applicant's argument that Beaty teaches away from the proposed combination (see page 10 of the amendment filed on 9/19/2002), Beaty teaches several embodiments, one of which includes a printer as a marking device (see column 3 lines 18-27), thus providing a lottery terminal with an automated cancellation device. Since, Walker et al teaches the lottery terminal including a printer 45 and Ehrhart et al teaches

Art Unit: 2876

the lottery terminal including an automated cancellation device 520, when combining the teachings of Beaty with the teachings of Walker et al and Ehrhart et al, one of ordinary skill in the art at the time of the invention would select the automated embodiment as taught by Beaty, since this is the embodiment that is analogous to the embodiments as taught by Walker et al and Ehrhart et al.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Meyerhofer et al (US 2002/0113124 A1) teaches a ticket printer that may validate and, if necessary, void tickets (see abstract). Lawandy et al (US 6,047,964) teaches a terminal, system and method for canceling lottery tickets (see figure 15 and column 14 lines 13+, for example).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared J. Fureman whose telephone number is (703) 305-0424. The examiner can normally be reached on 7:00 am - 4:30 PM M-T, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Art Unit: 2876

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

June 14, 2003

Jared J. Fureman
Jared J. Fureman
Art Unit 2876